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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/073,399 | 02/11/2002 | Evgeny I. Rivin | | 3984 |

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EXAMINER

BURCH, MELODY M

ART UNIT PAPER NUMBER

3683

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/073,399 | Applicant(s) RIVIN, EVGENY I. | |
| | Examiner Melody M. Burch | Art Unit 3683 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-26 is/are pending in the application.
- 4a) Of the above claim(s) 17, 18 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15, 16, 19, 20, 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 21-25 have been renumbered claims 22-26 and the phrase "claim 21" in line 1 of renumbered claims 23-26 has been changed to --claim 22-- for examining purposes.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15, 16, 19, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 2819060 to Neidhart.

Re: claims 15, 16, 22, and 23. Neidhart shows in figure 4 a bushing comprising: a rigid inner sleeve 1 having a substantially cylindrical outer surface, a rigid outer sleeve 2 having a substantially cylindrical inner surface spaced apart from the outer surface of the inner sleeve, a plurality of separate spaced apart rubber elements 3 disposed between the sleeves each element having a smooth outer surface coupled to the outer

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surface of the inner sleeve and to the inner surface of the outer sleeve, and wherein the elements are preloaded through compression to control the relative movement between the sleeves.

Re: claim 19. Neidhart shows in figure 4 a shoe 6 disposed between the outer sleeve (the right portion of) and at least some of the elements (the left portion of) and an actuator 8 coupled to the outer sleeve for adjusting the level of preload compression.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neidhart.

Neidhart lacks the specific recitation of the elements being torroidal, spheres, or ellipsoids.

In *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant.

6. Claims 15, 16, 19, 20, 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenzweig.

Re: claims 15, 16, 22, and 23. Rosenzweig shows in figure 3 a bushing

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comprising: a rigid inner sleeve 27 having an outer surface, a rigid outer sleeve 19 having an inner surface spaced apart from the outer surface of the inner sleeve, a plurality of separate spaced apart elements 35 disposed between the sleeves each element having a smooth outer surface coupled to the outer surface of the inner sleeve and to the inner surface of the outer sleeve, and wherein the elements are preloaded through compression to control the relative movement between the sleeves.

Rosenzweig lacks the recitation of the sleeves having cylindrical shapes.

In *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant.

Rosenzweig lacks the limitation of the elements being rubber.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the elements to have been rubber since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin* 125 USPQ 416.

Re: claims 19 and 20. Rosenzweig shows in figure 3 a shoe 36 disposed between the outer sleeve and at least some of the elements and an actuator 37 coupled to the outer sleeve for adjusting the level of preload compression.

Re: claims 22-26. Neidhart lacks the specific recitation of the elements being round or elliptical cross-section, torroidal, spheres, or ellipsoids.

In *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant.

Response to Arguments

7. Applicant's arguments filed 11/23/05 have been fully considered but they are not persuasive. With regards to claim 15 Applicant argues that "since cones are not cylinders, anticipation is precluded." Examiner notes that the sleeves of Neidhart are not cones but are truncated conical components. Examiner further notes that the claim does not recite cylinders, but a sleeves having a "*substantially* cylindrical" inner surface. Examiner maintains that, as broadly recited, Neidhart, shows with elements 1 and 2 sleeves having *substantially* cylindrical inner surfaces. Examiner also points out that a small height of element 1 or 2 closely resembles a shape that is substantially cylindrical.

Applicant also argues that the limitation of the elements being attached to one of the sleeves is not shown. Examiner maintains that elements 3 are attached or made to stay in place on sleeve 1 by way abutting contact with sleeve 2.

Applicant argues that the shoe of Neidhart is not disposed between the outer sleeve and at least some of the elements. Examiner disagrees and directs Applicant's attention to figure 4 in which shoe 6 is between the bottom of sleeve 2 and the top two elements 3.

Applicant argues that the limitation of elements that are of a shape that demonstrate a low stress concentration under compression is not shown. Examiner notes that this limitation is shown in Neidhart to the same extent that it is shown in the instant application. Examiner also notes that the elements 3 are cylindrical in a sense that they have a small height extending in the circumferential direction and include a circular cross-section.

Applicant disagrees with the rejection of claims 24-26 stating that the positively recited structural limitations require examination. Examiner maintains that the claims were examined. The examination of claims 24-26 concluded in a rejection based on case law. The use of case law to reject claims does not suggest that there was no examination of the claims.

With regards to the limitation of preloading through compression to control the relative movement between the sleeves, Examiner maintains that components 37 are used to preload through compression of the plates 36 against the elements to control the relative movement resulting from looseness, for example, between the sleeves. Therefore, the limitation, as recited, is satisfied by the prior art of record.

Applicant argues that the cylindrical shapes "important and in need of examination". Again Examiner notes that the use of case law to reject claims does not suggest that there was no examination of the claims. It is appropriate to use case law absent a specific explanation of criticality. Simply stating that a limitation is "important" does not provide an explanation of criticality.

Accordingly, the rejections have been maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mmb
January 30, 2006

Melody M. Burch
Melody M. Burch
Primary Examiner
Art Unit 3683
1/30/06